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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,279	10/29/2003	Joseph D. Rainville	GP-303951	6502
65798	7590	12/04/2007		
MILLER IP GROUP, PLC GENERAL MOTORS CORPORATION 42690 WOODWARD AVENUE SUITE 200 BLOOMFIELD HILLS, MI 48304			EXAMINER HODGE, ROBERT W	
			ART UNIT 1795	PAPER NUMBER
			MAIL DATE 12/04/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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Mailed: 12-4-07

In re application of
Rainville, Joseph D.

Serial No. 10/696,279

Filed: October 29, 2003

For: CENTRIFUGAL COMPRESSOR SURGE
DETECTION USING A BI-DIRECTIONAL
MFM IN A FUEL CELL SYSTEM

DECISION ON
PETITION

This is a decision on the PETITION UNDER 37 CFR 1.144 TO REMOVE THE REQUIREMENT FOR RESTRICTION, filed on March 14, 2007.

On September 26, 2006 a Requirement for Restriction between two groups of Inventions was mailed. On October 26, 2006 a Response to the Restriction Requirement including an election of Group I with traverse was filed. A Non-Final Office Action was mailed on December 13, 2006 maintaining the restriction requirement and making it Final. A response to the Non-Final Office Action including amendments to the claims and remarks was filed on March 14, 2007. A Petition under 37 CFR 1.144 to remove the Requirement for Restriction was filed on March 14, 2007.

Petitioner has argued that a proper search for independent claim 1 would necessarily overlap a proper search for independent claim 15 and vice versa, thus Examiner has not shown burden in the requirement for restriction. Petitioner additionally argues that the Examiner has not established that the Inventions are distinct.

DECISION

Section 806.05(h) [R-3] Product and Process of Using of the MPEP states:

A product and a process of using the product can be shown to be distinct inventions if either or both of the following can be shown: (A) the process of using as claimed can be practiced with another materially different product; or (B) the product as claimed can be used in a materially different process.

The burden is on the examiner to provide an example, but the example need not be documented.

If the applicant either proves or provides a convincing argument that the alternative use suggested by the examiner cannot be accomplished, the burden is on the examiner to support a viable alternative use or withdraw the requirement.

Form *>paragraphs< 8.20 *>and 8.21.04 should< be used in restriction requirements between the product and method of using.

Section 808 [R-3] Reasons for Insisting Upon Restriction of the MPEP states:

Every requirement to restrict has two aspects: (A) the reasons (as distinguished from the mere statement of conclusion) why **>each invention<** as claimed **>is<** either independent or distinct **>from the other(s)<**; and (B) the reasons **>why there would be a serious burden on the examiner if restriction is not required, i.e., the reasons<** for insisting upon restriction therebetween as set forth in the following sections.

Section 808.02 [R-5] Establishing Burden of the MPEP states:

Where, as disclosed in the application, the several inventions claimed are related, and such related inventions are not patentably distinct as claimed, restriction under 35 U.S.C. 121 is never proper (MPEP § 806.05). If applicant voluntarily files claims to such related inventions in different applications, double patenting may be held.

Where the ***** inventions as claimed are shown to be independent or distinct under the criteria of MPEP § 806.05(c) - § 806.06, the examiner, in order to establish reasons for insisting upon restriction, must explain why there would be a serious burden on the examiner if restriction is not required. Thus the examiner must show by appropriate explanation one of the following:

(A) Separate classification thereof : This shows that each invention has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

(B) A separate status in the art when they are classifiable together : Even though they are classified together, each invention can be shown to have formed a separate subject for inventive effort when the examiner can show a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.

(C) A different field of search : Where it is necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other invention(s) (e.g., searching different classes /subclasses or electronic resources, or employing different search queries, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search.

Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among independent or related inventions

Petitioner argues that a proper search for independent claim 1 would necessarily overlap a proper search for independent claim 15 and vice versa. Petitioner argues that the Examiner has not shown a proper separate classification and a proper different field of search and has not identified a separate status in the art.

Section 808.02 of the MPEP indicates that burden can be established by appropriate explanation of **one of the following**: separate classification, or a separate status in the art, or a different field of

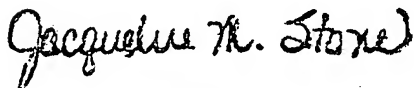
search. Examiner has established that the groups have separate classification (Group I, class 429/22 and Group II, class 429/13; see Restriction requirement filed 9/26/07 page 2). There is no additional requirement to show that there is also a separate status in the art and a different field of search, however these may also be shown. Petitioner has not rebutted this showing by appropriate showings or evidence.

Petitioner argues that independent claim 15 positively recites a method for detecting and eliminating a surge condition of a compressor in a fuel cell module and dependent claim 18 positively recites a by-pass valve in a cathode exhaust line of the fuel cell module, thus the Examiner has not shown that the Inventions of Group I and II are distinct.

Examiner indicated in the Restriction Requirement mailed on September 26, 2007 that the Groups are distinct (see MPEP 806.05(h)) by showing that the method of operating can be used for any fuel cell system that utilizes a compressor and not just the turbomachine compressor of the invention in claim 1. In the response to the traversal on December 13, 2006, Examiner further explained that the method can be practiced with another materially different product. (Note that the method claims do not require the particular fuel cell claimed in claim 1; the method could be practiced without the particulars of the fuel cell module, compressor, surge detection device or controller as claimed). Petitioner has not submitted evidence or identified evidence now of record showing that the inventions are obvious variants or clearly admitted on the record that this is the case.

Petitioner's arguments are not persuasive. The Examiner has properly established distinctness between the groups and serious burden. Accordingly, the Petition to remove the requirement for Restriction under 37 CFR 1.144 is **DENIED**. The Application is forwarded to the Examiner for consideration of the Amendment and Remarks filed on March 14, 2007.

It is noted, that all restriction requirements between a product and a process of using the product should be followed by form paragraph 8.21 (see John Love Memo April 25, 2007) and by form paragraph 8.21.04 to notify the applicant that if a product claim is found allowable, process claims that depend from or otherwise require all the limitations of the patentable product may be rejoined. (Notes 3 and 4, FP 8.20)



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